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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/424,116	01/06/00	LANG G	05725.0489

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EXAMINER	
LIOTT,C	
ART UNIT	**PAPER NUMBER**
1751	7

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/424,116	Applicant(s) Lang et al.
	Examiner Caroline D. Liott	Group Art Unit 1751

☐ Responsive to communication(s) filed on _____ .

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 26-60 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 26-60 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____ .

☒ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____ .

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 6

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Applicant's Preliminary Amendments filed 11/19/99 have been entered. Claims 1-25 have been canceled accordingly.

Claims 36, 39, 41 and 49 are objected to because of the following informalities: These claims contain typographical errors. Particularly, the claims appear to recite the letters "b" and "g" rather than the greek letters "beta" and "gamma." Appropriate correction is required.

Claim 36 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 36 is indefinite because the term "said para-phenylenediamine of formula (III)" lacks proper antecedent basis in the claims.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was

made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 26-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lang in view of Konrad.

Lang, U.S. Patent No. 4,025,301, teaches compositions for dyeing hair which contain at least one cationic dye of the formula exemplified which encompasses dyes of formula (I) as claimed, wherein the dye is present in the claimed amounts at the claimed pH's in mediums as claimed, see Abstract and col. 2, lines 2-13. The patentee teaches that the compositions may also contain oxidation dyes, and may be mixed with hydrogen peroxide before application to the hair as claimed, see col. 3, lines 42-51. Lang exemplifies various 3-aminopyridine dyes as claimed, see Examples such as 8-15, 20-24 and 27-29. In Example q, Lang exemplifies a composition which contains the dye of Example 14 (a dye of formula (I) as claimed), oxidation bases including p-toluenediamine, p-aminophenol and N-methyl-p-aminophenol sulfate, and couplers including m-aminophenol, all in the claimed amounts in a medium as claimed. The composition is mixed with a hydrogen peroxide oxidant, and is applied to hair in a dyeing method as claimed. Lang does not teach the claimed couplers of formula (II), or the claimed kits.

Konrad, U.S. Patent No. 4,588,410, teaches compositions for dyeing hair which contain a coupler of formula (I), which encompasses couplers of formula (II) as claimed, see Abstract. Konrad teaches that such couplers, parricularly the claimed (2'-hydroxyethyloxy)-2-hydroxy-4-aminobenzene, is an improvement over the conventionally used m-aminophenol coupler because it

results in more fashionable tones when combined with conventional developers such as p-aminophenols and p-diamines, see col. 2, line 24-col. 3, line 12.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to at least partially substitute the m-aminophenol coupler in the compositions and processes of Lang (which use oxidation bases and direct dyes of formula (I) as claimed), resulting in dyeing compositions and processes as claimed, because Lang does not require any specific oxidation dyes for use in the patentee's compositions, and Konrad teaches that the claimed substituted m-aminophenols have various improvements over the conventionally used m-aminophenol such as improved tones when combined with conventional oxidation bases, including the bases exemplified by Lang. The storage of the compositions of Lang as modified by Konrad in kits as claimed would have been obvious to those skilled in the art because such kits are conventional for the storage of two-part oxidative hair dyeing compositions, absent a showing otherwise.

Examiner notes the comparative Examples in the specification which show that two compositions as claimed have increased color uptake as compared two compositions which differ only in that they contain m-aminophenol as coupler instead of 5-amino-2-methylphenol as claimed. This evidence is not deemed persuasive to overcome the above rejection for several reasons.

First, the closest prior art of record, Lang's Example q, was not compared. Lang's composition contains a mixture of oxidation bases and couplers, encompassed by the claims but not present in the compared compositions. It is unclear how these additional dyes effect the

overall results. Showings of unexpected results must compare the closest prior art. See *Ex parte Beck*, 9 USPQ 2d 2000 (BPAI 1987); *In re Birkel*, 201 USPQ 67 (CCPA 1979), and *In re Merchant*, 197 USPQ 785 (CCPA 1976).

Second, the evidence is not commensurate in scope with the claims. Particularly, the claims allow for countless mixtures of dyes of formula (I) in combination with any oxidation base and a coupler of formula (II), wherein each component may be present in virtually any amount at any pH. Two combinations as claimed were compared, wherein both combinations contained the same oxidation base and coupler, i.e. p-phenylenediamine and 2-methyl-5-aminophenol. Such a limited showing is not representative of the full scope of the claimed invention. Evidence of unobviousness must be commensurate in scope with the claims. See *In re Kulling*, 14 USPQ 2d 1056, 1058 (Fed. Cir. 1990).

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 26-60 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 18-42 of copending Application No. 09/424,119 in view of Rose.

The claims of the copending application recite hair dyeing compositions, processes and kits which contain and/or use at least one oxidation base in combination with a 3-aminopyrimidine of formula (I) as claimed, wherein each component is present in the claimed amounts in the claimed mediums at the claimed pH's, and wherein the compositions are applied to hair in dyeing methods with oxidants as claimed. The copending claims recite that the composition may contain a coupler, see copending claim 35. The copending claims do not specifically teach the claimed m-aminophenol couplers.

Rose, U.S. Patent No. 4,976,742, teaches m-aminophenols couplers of formula (I) which overlap in scope with those of formula (II) as claimed, and wherein Rose's preferred couplers include those as claimed, see Abstract and col. 2, lines 39-42. Rose teaches that the couplers are particularly fast to light and rubbing, and may be combined with conventional developers and substantive dyes (i.e. direct dyes) for dyeing hair, see col. 2, lines 3-9 and 48-51; and col. 3, lines 16-19.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add a m-aminophenol coupler as claimed to the compositions, processes and kits of copending application No. 09/424,119, because the claims of the copending application teach that couplers may be added while not requiring any specific couplers, and Rose teaches that the

claimed couplers not only are suitable for use with conventional oxidation bases and direct dyes, but also lead to dyeings with good fastness properties.

This is a provisional obviousness-type double patenting rejection.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited prior art teaches mixtures of oxidation bases and couplers as claimed.

Applicant is reminded that if any evidence is to be presented in accordance with 37 CFR 1.131 or 1.132, such evidence should be presented before final rejection in order to be considered timely.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Caroline Liott whose telephone number is (703) 305-3703. The examiner can normally be reached on Mondays-Thursdays from 8:30am to 6:00pm, and on alternate Fridays.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Yogendra Gupta, can be reached at (703)308-4708. All before final official faxes should be sent to (703) 305-7718. All after final official faxes should be sent to (703) 305-3599. All non-official faxes should be sent to (703) 305-6078.

Any inquiry of a general nature should be directed to the Group receptionist whose telephone number is (703) 308-0661.

C.D.L.
December 29, 2000

CAROLINE D. LIOTT
PRIMARY EXAMINER